

REMARKS

Claims 1 through 18 remain pending in the present application. Claims 2, 3, 5, 6, 7, 11, 12, 18 have been amended. Basis for the amendments can be found throughout the specification, drawings and claims as originally filed.

Claim Objections

Claims 2, 3, 5, 6, 7, 11, 12 and 18 have been objected to by the Examiner for various informalities. The claims have been amended to overcome the informalities and respectfully request the Examiner to withdraw his objections.

Rejection Under 35 U.S.C. §103

The Examiner has rejected all of the claims under 35 U.S.C. §103(a). The Examiner rejects Claims 1, 2, 4 through 6, 8 through 11, 13 and 14 as being unpatentable over Bell in view of Clontz; Claims 15 through 18 as being unpatentable over Bell and Clontz further in view of Bunyea et al; and Claims 3, 7 and 12 over Bell, Clontz, further in view of Hines.

The invention relates to a power tool including a housing, a motor, a power source, an output coupled with the motor and an activation member for activating and deactivating the motor which, in turn, drives the output. A measuring device is positioned in the housing. The measuring device is usable while in the housing. Further the measuring device is removable from the housing to be used outside of the housing.

The Examiner rejects independent Claims 1, 5 and 10 as being unpatentable over Bell in view of Clontz. The Examiner alleges that this combination of references would illustrate Applicant's invention. The Bell reference, cited by the Examiner,

illustrates a motor driven hammer. The hammer includes a handle with a head section, as well as an enlarged tube section. The enlarged tube section, at the end of the handle, includes batteries 28. Nowhere does Bell disclose or suggest the need or the desire to have any type of measuring device. The Examiner alleges that the Clontz reference could be coupled with Bell to teach the present invention. Clontz illustrates a tape measure at the end of a hammer handle. The tape measure is elongated in order to fit into the hammer handle. Thus, the tape measure with its two coiled springs, gears and shafts, takes up a significant amount of space in the handle end of the hammer.

The court of appeals for the federal circuit, in In re Fritch, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992), stated that:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absence some teaching or suggestion supporting the combination. Under §103, teachings of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. A mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” at 1783 (Emphasis original)

Here, there is no motivation or suggestion of the desirability to combine the references as suggested by the Examiner. Nowhere does Bell suggest the need for a measuring device. Likewise, the Clontz reference neither discloses nor suggests utilizing the tape measure on a power tool.

“The Examiner is relying upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention’.” In re Fritch, supra, 1784.

This is exactly what the Examiner has done in applying his §103 rejection. The Examiner is taking bits and pieces of each reference alleging that it would render Applicant's invention obvious. The Examiner has failed to realize that by combining the references, as suggested, the primary reference, Bell, would need to be significantly modified to compensate for the batteries and tape measure in the same area. Thus, there is no motivation or suggestion to modify Bell since, in doing so, the Bell reference would need to be significantly modified in order to be adapted to utilize the Clontz reference.

The Examiner is just using hindsight reconstruction to combine the two unrelated references to allegedly render Applicant's invention obvious. Clearly, this is not the intent of §103. Accordingly, Applicant believes Claims 1, 2, 4 through 6, 8 through 11, 13 and 14 to be patentably distinct over the art cited by the Examiner.

The Examiner has combined Bunyea et al with the above two references to allegedly render Claims 15 and 18 obvious to those skilled in the art. The combination of Bunyea et al, fails to overcome the deficiency of the Bell and Clontz references. Thus, Claims 15 through 18 are patentably distinct over the art cited by the Examiner.

The Examiner has rejected Claims 3, 7 and 12 as being unpatentable over the above references further in view of Hines. The Hines reference fails to remedy the deficiencies of the Bell and Clontz reference. Thus, Applicant believes Claims 3, 7 and 12 to be patentably distinct over the art cited by the Examiner.

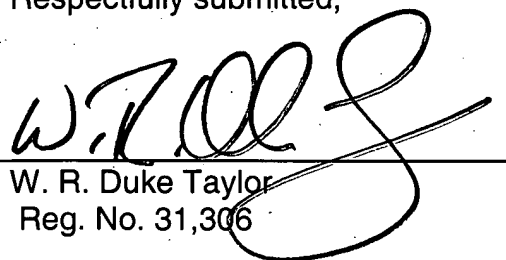
In light of the above amendments and remarks, Applicant submits that all pending claims are in condition for allowance. Accordingly, Applicant respectfully requests the Examiner to pass the case to issue at his earliest possible convenience.

Should the Examiner have any questions regarding the present application, he should not hesitate to contact the undersigned at (248) 641-1600.

Respectfully submitted,

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